

Application Serial No. 10/822,920

REMARKS

The Applicants and the undersigned thank Examiner Wong for her careful review of this application. Consideration of the present application is respectfully requested in view of the foregoing amendments and following remarks. Through this response, Claims 17, 20-23, 34, and 37 have been amended. Claims 17, 23, and 37 remain the independent claims.

A. STATEMENT OF THE REJECTION

The Examiner has initially rejected Claims 17-46. The Examiner rejected Claims 17, 23, and 37 on the basis of non-statutory obviousness-type double patenting in view of U.S. Patent No. 6,741,993. The Examiner rejected Claims 17-22 under 35 U.S.C. § 112, second paragraph, as allegedly failing to particularly point out and distinctly claim the subject matter which the Applicants regard as the invention. The Examiner rejected Claims 23-31, 33, and 36 under 35 U.S.C. § 101 as allegedly failing to claim statutory subject matter. Finally, the Examiner rejected Claims 17-46 under 35 U.S.C. § 102(b) as allegedly being anticipated by U.S. Patent No. 5,924,072 ("Havens").

B. TRAVERSAL OF THE NON-STATUTORY DOUBLE-PATENTING REJECTION AND SUBMISSION OF TERMINAL DISCLAIMER

Applicants respectfully traverse the Examiner's conclusion that Claims 17, 23, and 37 are not patentably distinct from U.S. Patent No. 6,741,993. Nonetheless, to expedite allowance of the pending claims, Applicants request that the attached Terminal Disclaimer be entered. The Applicants respectfully submit that the attached Terminal Disclaimer renders the double-patenting rejection moot.

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C. TRAVERSAL OF THE REJECTION OF CLAIMS 17-22 UNDER 35 U.S.C. § 112, ¶ 2

Applicants respectfully traverse the Examiner's conclusion that the usage of "operable" renders Claims 17-22 indefinite under 35 U.S.C. § 112, second paragraph. However, to expedite allowance of the pending claims, the Applicants have removed the word "operable" and replaced it with "configured" to clarify that the language is intended to limit the scope of the respective claims. According to Merriam-Webster dictionary, "configured" means "to set up for operation especially in a particular way." Therefore, Applicants submit that the recitations following the use of the word "configured" in Claims 17-22 are positive limitations. Accordingly, the Applicants respectfully submit that the Examiner's rejections as to Claims 17-22 under the above-recited rejection are rendered moot.

D. TRAVERSAL OF THE REJECTION OF CLAIMS 23-31, 33, AND 36 UNDER 35 U.S.C. § 101

The Applicants respectfully traverse the Examiner's conclusion that Claims 23-31, 33, and 36 do not recite patentable subject matter under 35 U.S.C. § 101. However, to expedite the allowance of the pending claims, the Applicants have followed the Examiner's suggestion by amending Claim 23 to recite "generating a presentation of results for the competitive rewards analysis." Accordingly, Applicants submit that amended independent Claim 23, and dependent Claims 24-31, 33, and 36, produce a concrete, useful, and tangible result patentable under 35 U.S.C. § 101. In view of the above, the Applicants respectfully request that the Examiner withdraw the rejections as to Claims 23-31, 33, and 36.

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E. TRAVERSAL OF THE REJECTION OF CLAIMS 17-46 UNDER 35 U.S.C. § 102(B)

The Examiner has alleged that U.S. Patent No. 5,924,072 to Havens discloses each and every element of Claims 17-46 of the present application. In view of the distinctions between the Havens patent and the invention defined by the pending claim set, as illustrated through the following remarks, the Applicants respectfully request that the Examiner withdraw the rejection as to Claims 17-46.

1. Havens does not disclose or suggest storing raw competitive data

Claims 17, 23, and 37 recite receiving raw competitive rewards data for employees of an entity and sources other than the entity. In contrast, Havens instructs receiving "knowledge items" from a submitter (i.e., an employee of an organization). (Column 3, lines 1-12). Havens states that a "knowledge item is any data, graphic, document, process, or other compilation of textual, audiovisual, multimedia, or other information concerning a topic of past, current, or potential future interest, usefulness, or applicability to the function of knowledge workers within the organization." (Column 3, lines 14-19). Thus, as described, Havens is directed to the management of intellectual capital within an organization (i.e., the management of past, current, and potential work product of employees of the organization). (See Column 1, lines 43-45). In contrast, Claims 17, 23, and 37 are directed to receiving competitive rewards data, including, but not limited to, salary information, incentives and total cash compensation, as well as other factors such as use of overtime, stock plans and cash awards (like performance bonuses and profit sharing). (Specification page 1, lines 19-22). As such, the competitive rewards data recited by Claims 17, 23, and 37 is different than the intellectual capital that is collected from employees in Havens. For the reasons cited, the

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Applicants respectfully submit that Havens does not disclose or suggest Claims 17, 23, and 37 and, therefore, request that the rejections as to those claims be withdrawn.

2. Havens does not disclose or suggest mapping raw competitive data received from multiple entities to employment-related benchmarks

Claims 17, 23, and 37 recite that the raw competitive rewards data received from multiple entities is mapped to benchmarks. For example, amended independent Claim 17 recites "mapping the raw competitive rewards data to benchmarks comprising job function, discipline or scope." Turning to the cited section of Havens as relied upon by the Examiner, the reference discloses establishing "knowledge envelopes" containing, for instance, "a title for knowledge item 8; a description, summary, or abstract of the contents of the knowledge item 8; a URL or any other appropriate location designator for addressing and accessing knowledge item 8; and any other information concerning knowledge item 8 that is suitable for inclusion in the knowledge envelope." (Column 5, lines 19-31). As stated, Havens describes a "knowledge item [as] any data, graphic, document, [etc.] ... concerning a topic of ... applicability to the function of knowledge workers *within the organization*." (Column 3, lines 14-19 (emphasis added)). Therefore, as opposed to mapping competitive rewards data to benchmarks, as required by Claims 17, 23, and 37, Havens describes storing knowledge item information in knowledge envelopes. Mapping to a benchmark, as recited by the claims, and storing, as recited by Havens, are different concepts. In the case of mapping, as recited by Claims 17, 23, and 37, the data is organized and stored according to a benchmark, whereas in Havens, data is simply stored. Further, as recited in Claims 17, 23, and 37, the raw competitive rewards data that is mapped to benchmarks includes information received from sources other than the entity. In contrast, Havens teaches a database solution for managing knowledge

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information within a single business entity. (Column 1, lines 11-18 and Column 2, lines 57-65).

In view of the above, the Applicants respectfully submit that Havens does not suggest or disclose mapping data to benchmarks, and further that Havens does not disclose or suggest mapping data from sources other than a single entity. Accordingly, the Applicants respectfully submit that the rejections as to Claims 17, 23, and 37 are improper and request that they be withdrawn.

3. Havens is directed to a system for receiving knowledge management information regarding a single entity, as opposed to the entity as well as other sources

The Havens patent discloses a computer-based knowledge management system 10 comprising databases 4 and 30 containing a knowledge item 8 and activity records 32, 34, and 36 associated with that knowledge item. Significantly, the knowledge management system 10 of Havens collects information from submitters 12, accessors 14, and supervisors 16 within a single business entity or organization to support the knowledge workers of that entity or organization. (Column 1, lines 11-18 and Column 2, lines 57-65). Within the environment of a single business entity, an accessor can access a knowledge item 8 and, in response, communicate feedback information concerning that knowledge item. The knowledge management system receives that feedback information, generates an incentive in response to the feedback information, and stores the incentive in one of the activity records 32, 34, or 36. (Column 1, lines 46-55). Havens teaches that "the behavior of knowledge workers within the organization may be channeled in such a way that total intellectual for capital is maximized" by using

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appropriate incentives for desirable knowledge worker activities. (Column 2, lines 20-24 and Column 3, lines 1-5).

In contrast to the single business or organization environment of the Havens patent, independent Claims 17, 23, and 37 receive and utilize competitive rewards data from sources other than the single entity. For example, amended Claim 17 recites a "competitive rewards database operative to receive raw competitive rewards data ... for employees of an entity and competitive rewards data *from a plurality of sources other than the entity*." (emphasis added). Similarly, amended independent Claims 23 and 37 recite, respectively, "receiving raw competitive rewards data .. for employees of an entity and ... a plurality of sources other than the entity" and "obtaining ... raw competitive rewards data ... comprising competitive rewards data for employees of the entity and ... from a plurality of sources other than the entity." Thus, while Havens teaches a knowledge management system for storing knowledge items from a single entity (e.g., single business organization), amended independent Claims 17, 23, and 37 provide an innovative system for maintaining competitive rewards data from an entity and sources other than the entity. Therefore, the Applicants respectfully submit that the rejections as to Claims 17, 23, and 37 are improper and request that they be withdrawn.

4. Havens is directed to a different solution than are Claims 17, 23, and 37

The Applicants respectfully submit that the Havens patent teaches a solution to a problem that is different from the one solved by independent Claims 17, 23, and 37. Havens teaches storing knowledge items to maximize intellectual capital of an organization, wherein the knowledge management system generates incentives for the submission of knowledge items by employees. Thus, Havens incents employees to

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submit and retain information relevant to past and future work projects in order to maximize the collected knowledge of the organization (i.e., maximizing intellectual capital). In contrast, independent Claims 17, 23, and 37 are directed towards collecting and utilizing competitive rewards data, wherein the competitive rewards data is received for employees of an entity and sources other than the entity. Although the Havens patent discloses the use of incentives, these incentives are distinguishable from the competitive rewards data recited by independent Claims 17, 23, and 37. As such, the Applicants respectfully submit that the rejections as to Claims 17, 23, and 37 are improper.

In view of the foregoing, the Applicants respectfully request that the Examiner withdraw the rejection of Claims 17, 23, and 37, as well as all claims dependent therefrom.

F. TRAVERSAL OF THE REJECTION OF DEPENDENT CLAIMS 18-22, 24-36, AND 38-46 UNDER 35 U.S.C. § 102(B)

Claims 18-22, 24-36, and 38-46 are patentably distinct from Havens for at least the reason that they depend from independent Claims 17, 23, and 37. If an independent claim is allowable, then the claims dependent thereon should also be allowable because they include the limitations of the independent claim. In re Fine, 5 U.S.P.Q.2d 1596, 1599 (Fed. Cir. 1988). Therefore, in view of the foregoing remarks with respect to independent Claims 17, 23, and 37, the Applicants respectfully submit that each dependent claim is patentable over the prior art.

Further, there are other grounds in support of the Applicants' assertion that dependent Claims 18-22, 24-36, and 38-46 are patentably distinct from Havens, some of which are discussed below.

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1. Havens does not disclose or suggest translating, scaling, reformatting or calculating portions of data for compatibility with benchmarks

Dependent Claim 26 further defines mapping the raw competitive rewards data to comprise "translating, scaling, reformatting or calculating portions" of the data "for compatibility with the benchmarks." Similarly, dependent Claim 27 specifies the use of a data capture tool to adjust the mapping of raw competitive rewards data. Applicants respectfully submit that Havens fails to disclose, teach, or suggest these recitations. As discussed above in connection with the independent claims of the present application, Havens does not teach mapping competitive rewards data, but instead only instructs storing information with regard to knowledge items in knowledge envelopes. Accordingly, Havens fails to disclose manipulation of competitive rewards data with regard to benchmarks. For this reason, the Applicants respectfully submit that Claims 26 and 27 are not disclosed or suggested by Havens.

2. Havens teaches away from providing automated data feeds to third parties

Dependent Claims 22, 29, and 41 specify that a rewards workbench is configured to automate data feeds from the competitive rewards database to at least one third party human resources management system. As stated above, Havens teaches a database solution for managing knowledge information within a single business entity. (Column 1, lines 11-18 and Column 2, lines 57-65). The Examiner points to Column 4, lines 13-31 to support the conclusion that Havens discloses Claim 22 and points to Column 3, lines 19-22 and 30-34, and Figure 3, to support the conclusion that Havens discloses Claims 29 and 41. However, the portions of Havens cited by the Examiner only confirms that Havens is directed to an analysis of knowledge items within an organization. For

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example, Havens states that "the retrieval process is coordinated with a periodic employee review process *of the organization* to give supervisor ... a valuable tool for assessing the ... performance of knowledge workers with respect to intellectual capital *of the organization.*" (Column 7, lines 17-22 (emphasis added)). Further, Havens states that a "knowledge item is any data, graphic, document, [etc.] ... concerning a topic of ... applicability to the function of knowledge workers *within the organization.*" (Column 3, lines 14-19 (emphasis added)). Moreover, Havens expressly states that it seeks to maximize total intellectual capital within an organization to gain a technical advantage in the global economy. (Column 4, lines 20-24). This goal of maximizing collected information is diametrically opposed to the sharing of accumulated information with third parties. Havens therefore teaches away from sending automated data feeds to a third party human resource management system, as recited by Claims 22, 29, and 41.

Further, Claims 29 and 41 recite that the automated data feed to a third party supports the submission of certain mapped competitive rewards data in the form of a survey to third party human resource management systems. For the reasons previously discussed, Havens teaches away from this solution recited by these claims. Accordingly, the Applicants respectfully submit that the rejections of Claims 22, 29, and 41 are improper and request that they be withdrawn.

3. **Havens does not disclose or suggest mapping competitive rewards data to benchmark global job matches**

Claims 33 and 45 recite data mapping raw competitive rewards data based on benchmark global job matches without manual intervention. Havens does not disclose these recitations. As discussed, Havens is directed to a single entity and does not disclose mapping competitive rewards data to benchmarks. Hence, it is also not directed to

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mapping competitive rewards data to "benchmark global job matches," as recited by Claims 33 and 45. Accordingly, the Applicants respectfully submit that the rejections of Claims 33 and 45 are improper and request that the rejections be withdrawn.

4. **Havens does not disclose or suggest generating an up-to-date mapping of competitive rewards data to at least one benchmark**

Claim 35 recites generating an up-to-date mapping of competitive rewards data to at least one benchmark. This is not disclosed by Havens. As discussed, Havens does not disclose mapping competitive rewards data to benchmarks and, therefore, does not disclose generating an up-to-date mapping of competitive rewards data to a benchmark, as recited by Claim 35. Accordingly, the Applicants respectfully submit that the rejection of Claim 35 is improper and request that it be withdrawn.

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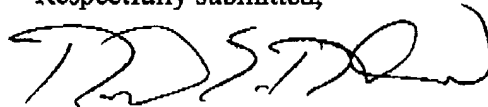
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CONCLUSION

The foregoing is submitted as a full and complete response to the Office Action mailed on December 20, 2006. The Applicants and the undersigned thank Examiner Wong for her consideration of these remarks. The Applicants have amended Claims 17, 20-23, 34, and 37 and have submitted remarks to traverse the initial rejections of Claims 17-46. The Applicants respectfully submit that the present application is in condition for allowance, and such action is hereby courteously solicited.

If the Examiner believes that there are any issues that can be resolved by a telephone conference, or that there are any formalities that can be corrected by an Examiner's amendment, please contact the undersigned at (404) 572-2746.

Respectfully submitted,



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